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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/757,462

01/15/2004

Tadashi Morita

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EXAMINER

LE, HUNG CHARLIE

ART UNIT

PAPER NUMBER

3663

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/757,462	MORITA ET AL.	
	Examiner	Art Unit	
	Hung C. Le	3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1- 14 is/are pending in the application.
- 4a) Of the above claim(s) 5, 7, 8, 10, 12 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 4, 6, 9, 11, & 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/21/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Claims 1 – 13 (Claims 5, 7, 8, 10 & 12 were cancelled by applicant) in the reply filed on 01/29/2007 is acknowledged.
2. Claim 14 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 01/29/2007.

Claim Rejections - 35 USC § 112

3. Claims 1, 2, 4, 6, 9, 11 & 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1:

Claim 1 recites the limitation "the user" in line 11. There is insufficient antecedent basis for this limitation in the claim.

With respect to claim 2:

Art Unit: 3663

Claim 2 recites the limitation "the new user" in line 6. There is insufficient antecedent basis for this limitation in the claim.

With respect to claim 4:

Lines 2 – 4 is unclear where in the specification and drawings that discloses "wherein the server discloses the terminal user information to a user of the terminal if the user information is to be-reused...". It is unclear whether the applicant refers to the existing user information for the new user information since the claim language is flip-flopping between "a user" and "the user".

With respect to claims 6, 9, 11 & 13:

The term "...out of a "preset" range..." is vague/unclear as do not know what "preset" is referred to.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 – 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obata

Art Unit: 3663

et al. (US2002/0123840) in view of Hisano et al. (US 2004/0204032).

With respect to claim 1:

Obata discloses (Fig. 1) a traveling machine management system comprising:

a terminal (vehicle terminal 100) provided on a traveling machine (shipping truck); and

a server (information center 200) connected to the terminal (100) through a communication channel (vehicle terminal communication server 220 and router 240), the server (200) configured to facilitate managing the traveling machine (shipping truck) (Section 26).

Obata further discloses (Fig. 4) the server (200) associating with a unique identifier (the terminal 100 having a unique identifier such as the vehicle number or ID, thus the terminal 100 can also be considered as a unique identifier) (Sections 26 And 27).

Obata also discloses (Figs. 5 and 6) the server has means (display screen) which acquires the identifier of the terminal (vehicle number or ID) and means (control center 200) which manages a communication period of the terminal based on the acquired identifier (Section 28, "a fixed time interval position reporting mode" is the claimed communication period having a start and an end with the terminal.)

Obata fails to explicitly teach wherein the server "indicating that the communication is from the user only during the communication period".

However, Hisano discloses (Figs. 1 and 4-7) a terminal (vehicle terminal 100) provided on a traveling machine (vehicle); and a server (service center 110) connected to the terminal (100) through a communication channel (control channel 120), wherein the server (110) indicating that the communications is from the user only during the communication period, which is the allocated time as indicated in Figs. 6 and 7 (Sections 19, 37-39, and 45).

Therefore, it would have been obvious to a person of ordinary skill in the art to use the wireless terminal of Hisano for the vehicle terminal of Obata to enabling the big capacity data via a high speed wireless communication network at a low cost using both a subscriber identification information and a wireless communication terminal identification information, which are used together with the other subscribers (See Hisano et al. Section 18+).

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

With respect to claim 2:

Obata further discloses (Fig. 1) the server (information center 200) has means

Art Unit: 3663

(monitor server 210 and vehicle terminal communication server 220) for acquires transfer information on the terminal.

Obata further discloses (Fig. 2) wherein the server further configured to facilitate acquiring user information indicating a new user of the terminal (Section 27, lines 10-25)

Furthermore, the type of information being transferred (such as resale/transfer user information) is not critical to the function of the system since the type of data being used or transferred is a non-functional descriptive material.

Furthermore, the process of updating a new user information of a wireless terminal, such as a cellular phone, PDA, or navigational device is conventional in the art.

Obata does not explicitly teach "means which rewrites information on the terminal accumulated in the server and/or the terminal".

However, since Obata teaches (Fig. 6, sections 35-36) the GPS position information is transferred back and forth between the vehicle terminal (100) and the server (information center 200), it would have been obvious to a person of ordinary skill in the art to recognize that the GPS position information can be rewrote or updated every time the position of the vehicle is changed or updated (See also section 27, lines 10 – 25).

With respect to claim 3:

Obata discloses (Fig. 1) the server (center information 200) has means (vehicle

terminal communication server and database 230), which inquires information prior to transfer (settings information, position information). Also the server (210) has a capability to determine whether the information will be reused during the updating communication period (as showed in arrow lines in Fig. 1).

With respect to claim 4:

Obata discloses (Fig. 1) the server (center information 200) has means (vehicle terminal communication server and database 230), which inquires the necessity information such as the vehicle number or position the prior to transfer.

Furthermore, it is unclear where in the specification and drawings that discloses "wherein the server discloses the user information to a user of the terminal if the user information is to be re-used". It is unclear whether the Applicant refers to the existence user information or the new user information since the claim language is flip-flopping between "a user" and "the user".

Furthermore, the type of information being transferred (such as resale/transfer user information) is not critical to the function of the system since the type of data being used or transferred is a non-functional descriptive material.

The process of updating a new user information of a wireless terminal, such as a cellular phone, PDA, or navigational device is conventional in the art.

Obata fails to teach the server has means to notify the terminal, instead of the terminal notifies the server when the communication period has expired. However,

it is well known in the art that in the networking system, both the server and client can transfer communication information back and forth to each other.

6. Claims 6, 9, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obata in view of Hisano as applied to claims 1 and 2 above, and further in view of Gray et al (4,651,157).

With respect to claims 6, 9, 11 & 13:

Obata further discloses (Fig. 1) the vehicle terminal (100) has means (GPS), which acquires the current position of the traveling machine (truck) carrying the terminal (100).

The server (200) has means (monitoring sever 210 and database 230), which acquires the current position information output by the terminal (100).

Obata fails to teach the server outputs alarm information when the terminal is outside a preset range.

However, Gray discloses (Figs. 1 and 2) a well-known security monitoring and tracking system for vehicle based on the range of distant radius (Column 3, lines 15-28 and column 4, lines 15-27).

Therefore, since Obata also teaches his "system of reporting positions at

Art Unit: 3663

specified time intervals when the vehicle is outside the maximum defined radius from the delivery site is called a fixed time interval position reporting mode." (Page 3, second column, lines 1-10), it would have been obvious to use the security and alarming system of Gray into the traveling machine management system of Obata and Hisano to provide a more effective vehicle tracking system having an automatically alerting capability upon crossing an defined radius (See Gray, Col. 3, Lines 25+).

7. The statements of intended use or field of use, e.g., "setting..., acquiring..., notifying..., updating..., interacting..., for notifying..., for outputting..., etc..." clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch

& Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung C. Le whose telephone number is 571-272-8757. The examiner can normally be reached on M-F: 07:30am - 05:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/757,462

Page 11

Art Unit: 3663

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03/03/07



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SUPERVISORY PATENT EXAMINER